

REMARKS / ARGUMENTS

The present application includes pending claims 1-31, all of which have been rejected. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 1, 11, and 21 have been rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description requirement. Claims 1-31 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,970,919, issued to Doi, et al. (hereinafter, Doi). The Applicant respectfully traverses these rejections at least based on the following remarks.

I. Rejection under 35 U.S.C. § 112

Claims 1, 11, and 21 have been rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description requirement. The Office Action states the following:

Regarding claims 1, 11, and 21, the newly added limitation "wherein each network connection on the first communication path has a corresponding network connection on the second communication path" is not disclosed by the original specification.

See the Office Action at page 2. The Applicant respectfully disagrees. The Examiner is referred to, for example, FIG. 2 of the present specification and corresponding description in ¶¶ 41-54. As clearly explained in the above-

referenced paragraphs, **the physical network connections are illustrated in FIG. 2 with solid lines, and the logical level communication pathways are illustrated as “corresponding dashed lines having double-ended arrows.”** See the present specification at ¶ 41. **This is also clearly seen in FIG. 2, where the physical network connections (in solid lines) have a corresponding separate logical level communication pathways (in dashed lines).**

At least for the above reasons, the Applicant submits that claims 1, 11, and 21 are allowable and the rejection under 35 U.S.C. 112, first paragraph, should be withdrawn.

II. Examiner’s “Response to Arguments” Section

The Examiner states the following in the Office Action:

Doi teaches communication path between two end points (see figure 25) and where each node on first path connected to multiple nodes which allows the implementation of route cancellation and second path. Doi illustrates a smaller scale of route cancellation, where:

- first path (edge 1 - A - D - G - J - edge 7)
- second path (edge 1 - A - F - I - G - J - edge 7)

The system is capable of canceling route as in figure 26 where node D is canceled and rerouted the traffic through nodes F, I, and G. It is inherent for the system to reroute the path in a larger scale such that first and second path would be independent to each other based on the canceling capability. Therefore, it meets that first and second path are independent to each other and rejection respectfully remains.

See the Office Action at page 7. The Applicant respectfully disagrees. As already explained in the January 2, 2008 response, the Examiner's "first path" and "second path" (as listed above) are not independent of each other. Namely, both the "first path" and the "second path" utilize three common links (edge 1 – A, G – J, and J – edge 7). At least for these three common links, Doi does not disclose or suggest that a network connection on the "first path" has a corresponding network connection on the "second path", at least based on the facts that the "first path" and the "second path" are the same for these three links. Therefore, Doi does not disclose that "each network connection on the first communication path has a corresponding network connection on the second communication path."

Additionally, it appears that claims 1-31 are also being rejected based on **inherency**.

The Applicant submits that a rejection based on inherency must include a statement of the rationale or evidence tending to show inherency. See Manual of Patent Examining Procedure at § 2112. "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." See *id. citing In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the

reference, and that it would be so recognized by persons of ordinary skill. **Inherency, however, may not be established by probabilities or possibilities.** The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

The Applicant respectfully submits that neither Doi itself nor the Office Action “make[s] clear that the missing descriptive matter,” said to be inherent “is necessarily present in” Doi

A rejection based on inherency must be based on factual or technical reasoning:

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

The Applicant respectfully submits that the Office Action does not contain a basis in fact and/or technical reasoning to support the rejection based on inherency. Instead, as recited above, at least claim 9 of the present application stands rejected based on a conclusory statement of inherency, rather than upon a “basis in fact and/or technical reasoning.” Accordingly, the Applicant respectfully

submits that, absent a “basis in fact and/or technical reasoning” for the rejection of record, that rejection should be reconsidered and withdrawn.

CLAIM REJECTIONS UNDER 35 U.S.C. § 102

III. Doi Does Not Anticipate Claims 1-31

The Applicant first turns to the rejection of claims 1-31 under 35 U.S.C. 102(e) as being anticipated by Doi. With regard to the anticipation rejections under 102(e), MPEP 2131 states that “[a] claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” See Manual of Patent Examining Procedure (MPEP) at 2131 (internal citation omitted). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” See *id.* (internal citation omitted).

A. Rejection of Independent Claim 1 under 35 U.S.C. § 102(e)

With regard to the rejection of independent claim 1 under 35 U.S.C. § 102(e), the Applicant submits that Doi does not disclose or suggest at least the limitation of “establishing a second communication path that is independent of a first communication path that couples at least two end points via at least a first broadband network, wherein each network connection on said first communication

path has a corresponding network connection on said second communication path,” as recited by the Applicant in independent claim 1.

The Office Action states the following:

Regarding claim 1, Doi et al. teaches a method and system for network management (see column 2 line 21-31) comprising: establishing a second communication path (see col.15 line 37 - 65 edge 1 and edge 7 via nodes F, I, G, and J and figure 26) that is independent of a first communication path (see col.14 line 45 - col. 15 line 36 edge 1 and edge 7 via node A, node D and node G and node J and figure 25) that couples at least two end points via at least a first broadband network (see figure 25 and 26);

See the Office Action at page 3. Referring to Figures 25 and 26 of Doi, the Examiner is referring to a “second communication path” between edges 1 and 7. More specifically, the Examiner is equating the “second communication path” to include the path [edge 1 – A – F – I – G – J – edge 7]. Furthermore, the Examiner is equating the “first communication path” to include the path [edge 1 – A – D – G – J – edge 7]. Initially, the Applicant points out that **the path [edge 1 – A – F – I – G – J – edge 7] is not “independent of” the path [edge 1 – A – D – G – J – edge 7] since both paths include three common links (edge 1 – A, G – J, and J – edge 7) and each of these three common links can be used in either the first or the second communication path.** In other words, at any given time, each of the three common links can be used in only one communication path, and cannot be used independently in both communication paths.

Furthermore, the Applicant points out that **each network connection on the first communication path** [edge 1 – A – D – G – J – edge 7] **does not have a corresponding network connection on the second communication path** [edge 1 – A – F – I – G – J – edge 7]. The Examiner is using the virtual path between nodes F and G (Figure 26 of Doi, dotted line) as part of the second communication path. As clearly stated in Doi, **there is no physical link between nodes F and G**. See Doi, col. 15, lines 56-59. **Therefore, each network connection on the first communication path does not have a corresponding network connection on the second communication path.**

Therefore, the Applicant maintains that Doi does not disclose or suggest at least the limitation of “establishing a second communication path that is independent of a first communication path that couples at least two end points via at least a first broadband network, wherein each network connection on said first communication path has a corresponding network connection on said second communication path,” as recited by the Applicant in independent claim 1.

Accordingly, independent claim 1 is not anticipated by Doi and is allowable. Independent claims 11 and 21 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 11 and 21 are also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1.

B. Rejection of Dependent Claims 2-10, 12-20 and 22-31

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11, and 21 under 35 U.S.C. § 102(e) as being anticipated by Doi has been overcome and requests that the rejection be withdrawn. Additionally, claims 2-10, 12-20 and 22-31 depend from independent claims 1, 11, and 21, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 1-31.

CONCLUSION

Based on at least the foregoing, the Applicant believes that all claims 1-31 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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